

II. REMARKS

In the above-referenced patent application, please enter the amendment and reconsider the application. It is believed that no new matter has been added.

In the Office Action dated 2 April 2010, claims 18-20, 46 have been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that these claims are obvious based on U.S. Patent No. 5,413,383 (Laurush) in view of U.S. Patent No. 5,315,508 (Bain).

In the Office Action dated 2 April 2010, claims 1-17, 22-45, 47-54 have been rejected pursuant to 35 U.S.C. Sec. 103. The Examiner contends that these claims are obvious based on Laurush in view of Bain and U.S. Patent No. 6,208,980 (Kara).

Claim 21 seems to have been omitted from examination.

In response the rejections are respectfully traversed in that there is at least one claim element not shown in the cited art - namely anything regarding a waybill – more so in cooperation with other elements of the respective claims. Illustratively, as per claim 1 and its dependents, the Office Action commencing at page 2 appears to contend that printing, at the distribution center, on the waybill area, a courier waybill is shown by “a shipping sheet (fig. 1)”. Laurush’s Fig 1 does not disclose a waybill.

It is noted for the Examiner that a sea waybill is “a contract for the shipment of goods (including loading and delivery by the carrier) by which the carrier undertakes to deliver the goods to the consignee named in the document.” *Delphi-Delco Electronics Systems v. M/V NEDLLOYD EUROPA*, 324 F. Supp. 2d. 403, 425 n. 12 (S.D.N.Y. 2004) (citing Thomas J. Schoenbaum, Admiralty and Mar. Law § 10-11, 63 (2d ed. 1994)). Unlike a traditional bill of lading, a sea waybill “is not a document of title; it functions merely as a non-negotiable receipt that may also serve as the contract of carriage.” 324 F. Supp. 2d. at 424-425 (citing Schoenbaum, at 63). Unlike traditional bills of lading, sea waybills are often issued as a short form or blank back document and “provide significant advantages to the shipper and the carrier

in terms of efficiency and speed because, in contrast to bills of lading, the original waybill does not need to be physically transported to its destination in order for the consignee to claim the shipment.” *Id.* at 425 (citing Schoenbaum, at 63 n. 25).

As a non-negotiable bill of lading, the sea waybill is subject to the Federal Bills of Lading Act (49 U.S.C. §§ 80101-80116) and the Harter Act (46 U.S.C. app. §§ 190-196) under U.S. law. The sea waybill would also be subject to the Carriage of Goods by Sea Act (“COGSA”) (46 U.S.C. app. §§ 1300-1315), but does not automatically apply by its terms because COGSA is limited only to documents of title. *See* 46 U.S.C. § 1301(b). COGSA can apply, however, by agreement of the parties. The case cited above, *Delphi-Delco*, addressed precisely such an issue. *See Delphi-Delco*, 324 F. Supp. 2d 403, at 424 (reiterating that “at a bare minimum, a bill of lading must explicitly incorporate COGSA’s provisions or refer in some way to the \$500 per package limitation in order to constitute prima facie evidence of fair opportunity.”) (citing *Royal Ins. Co. v. M.V. ACX RUBY*, No. 97 Civ. 3710 (MBM), 1998 WL 524899 at *3 (S.D.N.Y. Aug. 21, 1998).

Correspondingly, an air waybill is “[a] shipping document used for the transportation of air freight. It includes conditions, limitations of liability, shipping instructions, description of commodity, and applicable transportation charges. It is generally similar to a straight non-negotiable bill of lading and is used for similar purposes.” 15 C.F.R. § 30.1(c); *see also* 73 Fed. Reg. 31,555 (June 2, 2008) (to be codified at 15 CFR pt. 30.1). Therefore, like the sea waybill, “its terms dictate that the goods are consigned to a named person and are not to be delivered to bearer or to the order of a named person.” *American Banana Co., Inc. v. Venezolana Internacional de Aviacion S.A. (VIASA)*, 67 A.D.2d 613, 616, 411 N.Y.S.2d 889, 892 (1979). Simply stated, “[a]n air waybill is a written document describing the shipping arrangement between the air carrier and the shipper.” *Brink’s Ltd. v. South African Airways*,

93 F.3d 1022, 1025 n. 1 (2d Cir. 1996); *see also Avero v. Belgium Ins. v. American Airlines, Inc.*, 423 F.3d 73, 75 n. 1 (2d Cir. 2005)

Once more, as a non-negotiable bill of lading, the air waybill is subject to the Federal Bills of Lading Act (49 U.S.C. §§ 80101-80116) under U.S. law. Additionally, although the carriage of goods by air is covered by a wide array of international conventions, the most often cited is the 1929 Convention for the Unification for Certain Rules Relating to International Carriage by Air ("Warsaw Convention"). The Warsaw Convention reiterates that air waybills constitute a receipt for the goods and are evidence of a contract of carriage. *See* Warsaw Convention Art. 11 (stating "[t]he air consignment note is prima facie evidence of the conclusion of the contract, of receipt of the goods and the conditions of carriage."). However, it should be noted that the Warsaw Convention, as well as its subsequent Protocols, do not apply simply by operation of law, but rather, do so by agreement of contracting parties. *See B.R.I. Coverage Corp. v. Air Canada*, 725 F. Supp. 133 (E.D.N.Y. 1989).

In sum, like a sea waybill, an air waybill creates a contract between the shipper and the air carrier. Specifically, in *Ing v. American Airlines*, 2007 WL 420249 at *4 (N.D. Cal. 2007), the court made clear that "[a]n air waybill forms the basic contract between the shipper and the air carrier. *Southeastern Pac. Trans. Co. v. Comm'l. Metals Co.*, 456 U.S. 336, 342-3, 102 S.Ct. 1815, 72 L.Ed.2d 114 (1982)." And in *Gunby v. Pilot Freight Carriers, Inc.*, the court cited to several secondary sources when discussing who prepares a waybill. Specifically, the court stated "[a] waybill is 'a document prepared by the carrier of a shipment of goods that contains details of the shipment, route and charges.'" *Gunby v. Pilot Freight Carriers, Inc.*, 82 N.C.App. 427, 429, 346 S.E.2d 188, 190 (N.C. App. 1986) (citing *Webster's New Collegiate Dictionary*, 1334 (9th ed. 1985); *accord, Black's Law Dictionary*, 1429 (rev. 5th ed. 1979)). Thus, the carrier prepares the waybill for both sea and air shipments.

Returning to the particulars of the rejections, as per claim 1 and its dependents, the Office Action commencing at page 2 appears to contend that printing, at the distribution center, on the waybill area, a courier waybill is shown by “a shipping sheet (fig. 1)”. Laurush’s Fig 1 does not disclose a waybill. At page 2 of the Office Action, reference is made to the Laurush “shipping label” but again, Laurush’s does not disclose, or even mention, a waybill. Further, Bain does not teach or disclose a waybill either.

And turning to all of the cited art, with respect to all of the claims as amended, Kara too does not teach or disclose any apparatus or process that meets the requirements of being a waybill. The same is true for all claims – a case of prima facie obviousness has not been made out because at least one claim element has not been shown in the cited art, especially in cooperation with the other claim elements. Reconsideration is therefore respectfully requested. New claims are not shown as prima facie unpatentable for the same reasons.

An interview is also requested, and appreciation for the examination is again noted.

With respect to the present application, the Applicant hereby rescinds any disclaimer of claim scope made in the parent application or any predecessor or related application. The Examiner is advised that any previous disclaimer, if any, and the prior art that it was made to avoid, may need to be revisited. Nor should a disclaimer, if any, in the present application be read back into any predecessor or related application.

If allowance is not forthcoming, Applicant requests an interview with the Examiner.

APPLICANT CLAIMS LARGE ENTITY STATUS. The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235, and if any extension of time is needed to reply to said office action, this shall be deemed a petition therefore.

Please direct all communication to the undersigned at the address given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'PK Trzyna', with a horizontal line extending from the end of the signature.

Date: October 4, 2010

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